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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/901,722	07/11/2001	Akihiro Hikichi	03327.2259	7732
22852	7590	10/15/2004	EXAMINER	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 1300 I STREET, NW WASHINGTON, DC 20005			TORRES VELAZQUEZ, NORCA LIZ	
		ART UNIT	PAPER NUMBER	
		1771		

DATE MAILED: 10/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/901,722	HIKICHI ET AL.	
	Examiner	Art Unit	
	Norca L. Torres-Velazquez	1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 15 July 2004.
 2a) This action is **FINAL**. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1,2,6 and 7 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1,2,6 and 7 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>081104</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 1-2, 6, and 7 have been considered but are moot in view of the new ground(s) of rejection.
2. It is noted that the EP'406 reference applied below is treated as a 102(a) reference. With regards to the foreign priority date claimed in the present application, it is noted that no certified English translation is in file.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-2, 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over ROBERTS et al. (US 4,182,437) in view of YAMANE (EP 1081406A2).

ROBERTS et al. discloses a friction material for use in brake lining, clutch pads and the like. The reference teaches that in general, a friction material contains a matrix or binder, such as a thermosetting resin or vulcanized rubber, a fibrous reinforcement, and a friction modifier. (Column 1, lines 25-28) The reference provides an amorphous glass, which in finely divided form, is adapted for use as a combined friction modifier and reinforcing agent for friction material. (Col. 2, lines 49-53) The reference teaches the use of silicate glasses and teaches the use of SiO₂ systems with the following compositions in which Fe₂O₃ may optionally be used as a modifying oxide (refer to Column 4, lines 20-65; claim 11):

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SiO_2 : 60% to 75%;
 Li_2O : 10% to 30%;
 MgO : 8% to 20%;
 Fe_2O_3 : 0% to 5%

The reference further teaches that the glasses are smelted and fiberized and the fibers maybe either continuous or discontinuous. The diameter and length of the fibers are not at all critical and may vary widely. For example, a diameter may average from about a 0.5 micron to about 30 microns and usually is about 1.75 microns. Lengths, when continuous fibers are not used, may average from about 1 centimeter to about 50 centimeter. (Column 6, lines 64-68 through Column 7, lines 1-3) The reference further teaches that other finely divided forms can be employed such as powder or bead, which, if desired, can be fabricated form the fibers. (Column 7, lines 16-21) The reference teaches the use of an organic resin, elastomers and other additives, modifiers, filler, extenders can be added to the thermosetting organic resin. Further, the reference teaches that the proportions of these are not critical and that in general, the friction material contains in parts by weight from about 20 to about 80 parts of the resin, from about 5 to about 40 parts of the present finely divided glass. (Column 7, lines 16-65)

It is the Examiner's interpretation that ROBERTS et al. provides all the elements claimed in the present application. With regards to the inclusion of less than 10% of at least one of Al_2O_3 and ZrO_2 , it is the Examiner's interpretation that less than 10% could also be zero. Further, Roberts et al. also teaches the use of these as additives as disclosed in Col. 5, lines 23-28) With regards to the fiber diameter and length, it is noted that the reference teaches that these are not at all critical and may vary widely, as stated above. However, in the specification the reference teaches that the lengths may average from about 1 cm to about 50 centimeter, which is a range higher than the presently claimed. (Refer to col. 7, lines 1-3)

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The EP'406 reference is also directed to non-asbestos friction material and teaches the use of fiber lengths of the fibrous substance generally within a range of about 10 to 5,000 μm . [0016]

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify invention of ROBERTS et al. and provide with fibers of length in the range of 10 to 5,000 μm with the motivation of providing fibers that are not too short to lower the strength of the friction material and not too great of a length that would increase the abrasiveness to an excessive degree as disclosed by the EP'406 reference. [0016]

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Norca L. Torres-Velazquez whose telephone number is 571-272-1484. The examiner can normally be reached on Monday-Thursday 8:00-4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

NL
Norca L. Torres-Velazquez
Examiner
Art Unit 1771

October 12, 2004

Elizabeth M. Cole
ELIZABETH M. COLE
PRIMARY EXAMINER